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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,933	06/20/2001	Olivier Attia		3723

7590 09/10/2004
Avi Outmezguine
54 West 39th Street
Fourth Floor
New York, NY 10018

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,933

Applicant(s)

ATTIA, OLIVIER

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/20/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

The drawings filed on 6-20-2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 3 are rejected under 35 U.S.C. 112, second paragraph, for having 2 conflicting structural classes. For example, claim 1 recites that the claim is both a method and system.

Claim 2 recites, "techniques as described in the document" and such recitations are not permitted. Limitations appearing in the specification but not recited in the claim are not read into the claim. > E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (Claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily) [MPEP 2106].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara (US 6,577,861 B2) in view of Allard (US 6,249,733 B1).

Regarding claim 1, Ogasawara teaches a system and method comprises the following steps: uploading barcodes in using a personal scanner into a centralized repository, resolving this barcode into appropriate product identification (such as the SKU), storing this information in the repository in the form of customized shopping lists or folders (see at least Abstract, Col 2, lines 56 – 59, Col 4, lines 43 – 45 and Col 7, lines 18 – 20).

While Ogasawara discloses shopping list, the reference does not specifically disclose a method and system using these lists to conduct online shopping, creating or printing personalized Catalogs that include the product information of items within these shopping lists along an associated barcode.

On the other hand, Allard teaches a method and system using these lists to conduct online shopping, creating or printing personalized Catalogs that include the product

information of items within these shopping lists along an associated barcode (see at least Abstract and Col 2, lines 8 – 65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Ogasawara with the method and system of Allard to have enabled a system and method comprises the following steps: uploading barcodes in using a personal scanner into a centralized repository, resolving this barcode into appropriate product identification (such as the SKU), storing this information in the repository in the form of customized shopping lists or folders, using these lists to conduct online shopping, creating or printing personalized Catalogs that include the product information of items within these shopping lists along an associated barcode. Ogasawara discloses a method and system comprises the following steps: uploading barcodes in using a personal scanner into a centralized repository, resolving this barcode into appropriate product identification (such as the SKU), storing this information in the repository in the form of customized shopping lists or folders (see at least Abstract, Col 2, lines 56 – 59, Col 4, lines 43 – 45 and Col 7, lines 18 – 20). Allard discloses a method and system using these lists to conduct online shopping, creating or printing personalized Catalogs that include the product information of items within these shopping lists along an associated barcode (see at least Abstract and Col 2, lines 8 – 65). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Ogasawara with a method and system using these lists to conduct online shopping, creating or printing personalized Catalogs that include

the product information of items within these shopping lists along an associated barcode.

Regarding claim 2, system and methods that permits a User to drag and drop information from one folder to another using the drag-and-buy techniques as described in the document, particularly dragging a product from other folders into the shopping cart folder with the intention of using the contents of this folder to conduct online shopping. These techniques of using "drag and drop" are old and well known at the time of the invention. Therefore, one of ordinary skill would have been motivated to extend the combination of Ogasawara and Allard with a method and system with drag and drop capability. In this manner, the shopper can modify/update list by dragging and dropping items from other past shopping list.

Regarding claim 3, Allard teaches a system and methods to search and recommend product substitutes when a desired product is not available in the Products Repository - substitutes are searched in an internal Substitutes database, an internal repository of product and manufacturer information based on UPCs, and external registries or repositories of product and manufacturer information based on UPCs (see at least Col 2, lines 66 – 67 and Col 3, lines 1 – 2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450


or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RER


Jeffrey A. Smith
Primary Examiner